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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/559,810

05/12/2006

Akihiko Ueda

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23373 7590 03/04/2009  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|--|--|--|--|
| <p align="center"><b>Advisory Action</b><br/><b>Before the Filing of an Appeal Brief</b></p> | <p><b>Application No.</b><br/>10/559,810</p> | <p><b>Applicant(s)</b><br/>UEDA ET AL.</p> |  |
|  | <p><b>Examiner</b><br/>HENRY S. HU</p>       | <p><b>Art Unit</b><br/>1796</p>            |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 2-17-2009  
13. ☐ Other: \_\_\_\_\_.

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1796

Continuation of 11. NOTE: Three things including: (A) The reconsideration after final, (B) Declaration written by Akihiko Ueda, and (IDS (1 page) under Rule 1.132 have been thoroughly studied by this examiner. However, it does not place the application for allowance after final action because:

Current parent Claim 1 and its dependent Claims 2-3 and 5 are not further amended at all, they are thereby still fundamentally covered by those arguments discussed in the final office action. However, the examiner has recognized at least three key points from pages 2-3 (particularly on Applicants' rebuttal of page 3) of Remarks regarding the criticality of using the upper limit of 6 carbon atoms for Rf group.

First, Applicants' rebuttal with some experimental's results as shown in the Declaration under 1.132 may have showed excellent soil resistance for polymers prepared from both monomers (see page 3 at top section of Remarks). However, it will take time to check whether such result is indeed unexpected result. As known in the art, it may be good or excellent result. As discussed earlier, With the narrow down on the carbon atom numbers from 1-12 to 1-6, the carbon atom numbers (2-31 or 6-12) used by references are still "at least partially" overlapping with the new range 1-6. Additionally, Takanobu has used a fluoroalkyl having C2-31 in the formula (1) at abstract, while each of Wataru and Naoki has used C6-12 fluoroalkyl group-containing fluoroalkyl acrylate monomer as monomer (A). Therefore, it may be premature to make such a conclusion for unexpected result.

Second, several key points need to be checked. For instance, Applicants' results may be obtained from the use of  $-C-CO-C(Cl)=CH_2$  or  $-C-CO-C(F)=CH_2$  in comparison with  $-C-CO-CH=CH_2$  (see comparative examples 1 and 2). In other word, it is not achieved from the use of Rf being C1-6 in comparison with C>6.

Third, in case that 103 rejections are not able to sustain, some other references may be used to teach the silent thing.

In summary, a new consideration and search is thereby required to be sure of all the above three questions being thoroughly answered.

Examiner Henry Hu, au 1706, February 27, 2009